

REMARKS/ARGUMENTS

I. CLAIM AMENDMENTS

Claims 49, 174, 175, 179 and 181 have been amended and claims 60, 61, 62 and 88 have been canceled. Amended claim 49, which now includes the limitations of previously pending claims 60 and 61 or 62, has been amended to better capture the envisioned commercial embodiments. Claims 174, 175, 179 and 181 have been amended to correct dependency upon a canceled claim. Accordingly, no new matter has been introduced by way of these amendments. Claims 49-52, 55, 63, 66, 68, 71-73, 76, 80, 84, 166-181 are now pending.

II. THE OFFICE ACTION OF APRIL 19, 2005

A. THE REJECTIONS UNDER 35 U.S.C. 102(b) AND (e)

1. Mroczkowski

The Office Action of April 19, 2005 rejected claims 49-52, 55, 61-63, 66, 68, 76, 80, 84, 166, 168 and 176-179 as allegedly anticipated under 35 U.S.C. §102(b) by United States Patent No. 5,137,827 ("Mroczkowski").

Applicants have amended claim 49 to better capture the envisioned commercial embodiments. Claim 49 now includes the limitations of previously pending claim 60. And applicants note that previously pending claim 60 was not rejected as allegedly anticipated by Mroczkowski. Thus, Mroczkowski does not anticipate amended claim 49. Withdrawal of the Mroczkowski anticipation rejection is earnestly solicited.

2. Rembaum

The Office Action of April 19, 2005 rejected claims 49-52, 55, 60, 63, 66, 71-73, 76, 80, 84, 88, 166, 168-173 and 176-179 as allegedly anticipated under 35 U.S.C. §102(b) by United States Patent No. 4,929,400 ("Rembaum").

Applicants have amended claim 49 to better capture the envisioned commercial embodiments. Claim 49 now includes the limitations of previously pending claims 61 or 62. And applicants note that previously pending claims 61 or 62 were not rejected as allegedly anticipated by Rembaum. Thus, Rembaum does not anticipate amended claim 49. Withdrawal of the Rembaum anticipation rejection is earnestly solicited.

3. Margel

The Office Action of April 19, 2005 rejected claims 49-52, 55, 61-63, 66, 68, 71-73, 76, 80, 84, 166-173 and 176-179 as allegedly anticipated under 35 U.S.C. §102(b) by United States Patent No. 4,624,923 ("Margel").

Applicants have amended claim 49 to better capture the envisioned commercial embodiments. Claim 49 now includes the limitations of previously pending claim 60. And applicants note that previously pending claim 60 was not rejected as allegedly anticipated by Margel. Thus, Margel does not anticipate amended claim 49. Withdrawal of the Margel anticipation rejection is earnestly solicited.

4. Tarcha

The Office Action of April 19, 2005 rejected claims 49-52, 55, 62, 63, 66, 68, 76, 80, 84, 166, 168-173 and 176-181 as allegedly anticipated under 35 U.S.C. §102(e) by United States Patent No. 5,567,628 ("Tarcha").

Applicants have amended claim 49 to better capture the envisioned commercial embodiments. Claim 49 now includes the limitations of previously pending claim 60. And applicants note that previously pending claim 60 was not rejected as allegedly anticipated by Tarcha. Thus, Tarcha does not anticipate amended claim 49. Withdrawal of the Tarcha anticipation rejection is earnestly solicited.

B. THE REJECTIONS UNDER 35 U.S.C. §103

1. Mroczkowski

The Office Action of April 19, 2005 rejected claims 60, 88, 174 and 175 as allegedly being unpatentable under 35 U.S.C. §103 over Mroczkowski. Applicants have canceled claims 60, 62 and 88, thus rendering moot the obviousness rejection over Mroczkowski.

Applicants reiterate and incorporate by reference the arguments contained in the response to office action of October 19, 2005, regarding traversal of the obviousness rejections. Specifically, the Office Action of April 19, 2005 fails to establish a *prima facie* case of obviousness because the office action fails to establish any motivation to modify or combine the cited art to arrive at the claimed invention. Furthermore, the office action fails to establish a reasonable expectation of success in modifying or combining the cited art to arrive at the claimed invention.

The Office Action of April 19, 2005 establishes that Mroczkowski fails to disclose the limitations of previous claim 60. To overcome the deficiencies of Mroczkowski, however, the Office Action of April 19, 2005 alleges that it would have been a matter of routine skill in the art to discover the optimum or workable ranges of the coefficient of variation. *See Office Action of April 19, 2005*, page 8. The Office Action, therefore, appears to be asserting that discovering a workable coefficient of variation with a population of particles is a matter of routine experimentation. The Office Action, however, fails to establish that such a variable is recognized as a result-effective variable. And the MPEP clearly states that “[a] particular parameter *must first* be recognized as a result-effective variable, *i.e.*, a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation.” Manual Patent Examining Procedure (MPEP) §2144.05 8th Ed. (August, 2005) (emphasis added). Thus, the Office Action fails to account for all the limitations of the claimed invention within the cited art.

The Office Action of April 19, 2005 also establishes that Mroczkowski fails to disclose the limitations of claims 174 and 175. To overcome the deficiencies of Mroczkowski, however, the Office Action of April 19, 2005 alleges that it would have been a matter of routine skill in the art to discover the optimum or workable ranges of the thickness of coatings. *See Office Action of April 19, 2005*, page 8. The Office Action, therefore, appears to be asserting that discovering a workable thickness for coating the particles is a matter of routine experimentation. The Office Action, however, fails to establish that such a variable is recognized as a result-effective variable. Thus, the Office Action fails to account for all the limitations of the claimed invention within the cited art.

Thus, Mroczkowski can not be used to establish a *prima facie* case of obviousness over the claimed invention because the cited art fails to teach or suggest each and every limitation of the claimed invention. The Office Action also fails to establish that one of skill in the art would be motivated to modify or combine the cited art to arrive at the claimed invention with a reasonable expectation of success. Withdrawal of the obviousness rejection is earnestly solicited.

2. Margel

The Office Action of April 19, 2005 rejected claims 60, 88, 174 and 175 as allegedly being unpatentable under 35 U.S.C. §103 over Margel. Applicants have canceled claims 60, 62 and 88, thus rendering moot the obviousness rejection over Margel.

Applicants reiterate and incorporate by reference the arguments contained in the response to office action of October 19, 2005, regarding traversal of the obviousness rejections. Specifically, the Office Action of April 19, 2005 fails to establish a *prima facie* case of obviousness because the office action fails to establish any motivation to modify or combine the cited art to arrive at the claimed invention. Furthermore, the office action fails to establish a reasonable expectation of success in modifying or combining the cited art to arrive at the claimed invention.

The Office Action of April 19, 2005 establishes that Margel fails to disclose the limitations of previous claim 60. To overcome the deficiencies of Margel, however, the Office Action of April 19, 2005 alleges that it would have been a matter of routine skill in the art to discover the optimum or workable ranges of the coefficient of variation. *See Office Action of April 19, 2005*, page 9. The Office Action, therefore, appears to be asserting that discovering a workable coefficient of variation with a population of particles is a matter of routine experimentation. The Office Action, however, fails to establish that such a variable is recognized as a result-effective variable. Thus, the Office Action fails to account for all the limitations of the claimed invention within the cited art.

The Office Action of April 19, 2005 also establishes that Margel fails to disclose the limitations of claims 174 and 175. To overcome the deficiencies of Margel, however, the Office Action of April 19, 2005 alleges that it would have been a matter of routine skill in the art to discover the optimum or workable ranges of the thickness of coatings. *See Office Action of April 19, 2005*, page 9. The Office Action, therefore, appears to be asserting that discovering a workable thickness for coating the particles is a matter of routine experimentation. The Office Action, however, fails to establish that such a variable is recognized as a result-effective variable. Thus, the Office Action fails to account for all the limitations of the claimed invention within the cited art.

Thus, Margel can not be used to establish a *prima facie* case of obviousness over the claimed invention because the cited art fails to teach or suggest each and every limitation of the claimed invention. The Office Action also fails to establish that one of skill in the art would be motivated to modify or combine the cited art to arrive at the claimed invention with a reasonable expectation of success. Withdrawal of the obviousness rejection is earnestly solicited.

3. Margel and Tarcha

The Office Action of April 19, 2005 rejected claim 181 as allegedly being unpatentable under 35 U.S.C. §103 over Margel in view of Tarcha. Applicants have canceled claims 60, 62 and 88, thus rendering moot the obviousness rejection over Margel in view of Tarcha.

Applicants reiterate and incorporate by reference the arguments contained in the response to office action of October 19, 2005, regarding traversal of the obviousness rejections. Specifically, the deficiencies of Margel with respect to claim 49 have been established, and Tarcha does not cure these deficiencies. Neither Margel nor Tarcha, alone or in combination, teach or suggest a population of particles with a coefficient of variation of less than 5%. The Office Action of April 19, 2005 also fails to establish a *prima facie* case obviousness because the office action fails to establish any motivation to modify or combine the cited art to arrive at the claimed invention. Furthermore, the office action fails to establish a reasonable expectation of success in modifying or combining the cited art to arrive at the claimed invention. Thus, the combination of Margel and Tarcha can not be used to establish a *prima facie* case of obviousness over the claimed invention because the cited art fails to teach or suggest each and every limitation of the claimed invention. Withdrawal of the obviousness rejection is earnestly solicited.

4. Tarcha

The Office Action of April 19, 2005 rejected claims 60 and 88 as allegedly being unpatentable under 35 U.S.C. §103 over Tarcha. Applicants have canceled claims 60 and 88, thus rendering moot the obviousness rejection over Tarcha.

Applicants reiterate and incorporate by reference the arguments contained in the response to office action of October 19, 2005, regarding traversal of the obviousness rejections. Specifically, the Office Action of April 19, 2005 fails to establish a *prima facie* case of obviousness because the office action fails to establish any motivation to modify or combine the cited art to arrive at the claimed invention. Furthermore, the office action fails to establish a

reasonable expectation of success in modifying or combining the cited art to arrive at the claimed invention.

The Office Action of April 19, 2005 establishes that Tarcha fails to disclose the limitations of previous claim 60. To overcome the deficiencies of Tarcha, however, the Office Action of April 19, 2005 alleges that it would have been a matter of routine skill in the art to discover the optimum or workable ranges of the coefficient of variation. *See Office Action of April 19, 2005*, page 10-11. The Office Action, therefore, appears to be asserting that discovering a workable coefficient of variation with a population of particles is a matter of routine experimentation. The Office Action, however, fails to establish that such a variable is recognized as a result-effective variable. Thus, the Office Action fails to account for all the limitations of the claimed invention within the cited art.

Thus, Tarcha can not be used to establish a *prima facie* case of obviousness over the claimed invention because the cited art fails to teach or suggest each and every limitation of the claimed invention. The Office Action also fails to establish that one of skill in the art would be motivated to modify or combine the cited art to arrive at the claimed invention with a reasonable expectation of success. Withdrawal of the obviousness rejection is earnestly solicited.

III. THE ADVISORY ACTION OF NOVEMBER 16, 2005

Applicants respectfully disagree with Advisory Action of November 16, 2005. Nonetheless, Applicants have removed the limitation “wherein the color of light scattered by at least 90% of said particles of each said population upon illumination of each said population on a surface at a particle density of less than 0.1 particles per μm^2 with white light is indistinguishable to the human eye when viewed with less than 500 times magnification and without electronic amplification” solely to expedite prosecution.

In addition, Applicants respectfully disagree, for reasons already of record, with the use of Applicants’ own claims as evidence that “materials such as protein would be base materials and would not significantly interact with light in the visible region of the spectrum.” *Office Action of*

April 19, 2005, page 6. Applicants reiterate and incorporate by reference previous arguments of record regarding the impropriety of using Applicants' own disclosure as evidence of unpatentability.

CONCLUSION

Claims 49, 174, 175, 179 and 181 have been amended and claims 60-62 and 88 have been canceled. Applicants amended claim 49 to better capture the envisioned commercial embodiment, and believe the amendments to claim 49 overcome all outstanding rejections. The claim amendments do not introduce new matter. Accordingly, claims 49-52, 55, 63, 66, 68, 71-73, 76, 80, 84, 166-181 are pending.

Should the Examiner believe that further discussion of any remaining issues would advance the prosecution, he or she is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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